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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,311	06/19/2001	Steven B. Adler	AUS920010589US1	6894
50170	7590	08/14/2007	EXAMINER	
IBM CORP. (WIP)			HO, THOMAS M	
c/o WALDER INTELLECTUAL PROPERTY LAW, P.C.				
P.O. BOX 832745			ART UNIT	PAPER NUMBER
RICHARDSON, TX 75083			2132	
			MAIL DATE	DELIVERY MODE
			08/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/884,311	ADLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas Ho	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 August 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,12-17,19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,12-17,19 and 21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>7/7/2006</u>                             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                           |

**DETAILED ACTION**

The indicated allowability of claims 1-3, 12-17, 19 and 21-22 is withdrawn in view of the newly discovered reference(s) to Benantar et al., Tolopka et al., and Gifford et al.

Rejections based on the newly cited reference(s) follow. The delay in presenting these grounds of rejection is regretted.

***Specification***

1. The disclosure is objected to because of the following informalities: Page 1 lacks appropriate serial number for related applications.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. Claims 12, 15, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims recite various "means" elements but it is not clear what structure is being referred to. It is not clear whether the specification has described corresponding structure for the various "means" elements. It is requested that Applicant indicate the described structure to understand the scope of the instant claims.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 15, 16, and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims encompass non-statutory embodiments of a carrier wave nature.

Reference is made to suggested language from the interview conducted on 7/7/2006 with Mr. Steve Walder, to overcome this rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 12, 13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Benantar et al. (U.S. Pat. No. 5,787,427).

With respect to claims 1, 12, and 15: The Benantar reference describes an object-oriented system that provides security for objects by grouping objects that share common control access policies.

A method, in a data processing system, for handling personally identifiable information, said method comprising: providing, in a computer, a first set of object classes representing active entities in an information-handling process, wherein a limited number of privacy-related actions represent operations performed on data and wherein each of the active entities is a human being or legal entity [ see Figure 4, Object Group 1];

providing, in said computer, a second set of object classes representing data and rules in said information-handling process, wherein at least one object class has said rules associated with said data, and wherein said data represents said personally identifiable information [see Figure 4, Object Group 2]; and

processing transactions, in the data processing system, involving said personally identifiable information, using said computer and said first and second set of object classes, so as to enforce a privacy policy, associated with the personally identifiable information and defined by said rules, against one or more active entities represented by said first set of object classes [ see column 3, lines 1-20],

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wherein each of the one or more active entities represented by said first set of object classes is a human being or legal entity [ see column 3, lines 22-43] , wherein:  
a first active entity represented by a first object class in said first set of object classes is a first data user that requests personally identifiable information from a data subject that is a second active entity represented by a second object class in said first set of object classes,  
said data subject is an active entity that is personally identifiable by said personally identifiable information;  
a third active entity represented by a third object class in said first set of object classes is a second data user that requests personally identifiable information from said first data user, and  
said rules define if and how said personally identifiable information may be provided, by said first data user, to said second data user [ see column 5, lines 35 –50].

Further reference is made to column 6, lines 48-53.

Benantar discloses that the objects may represent various parties, see Figures 1 and 5, to address claims 2, 13, and 16.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benantar et al. (U.S. Pat. No. 5,787,427) in view of Tolopka et al. (U.S. Pat. No. 6,044,349).

The Benantar reference does not disclose an object class representing a filled paper form.

The secondary reference Tolopka teaches a storage medium for storing personal information that is subject to access control for apportion the data among authorized

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entities. Figure 2 shows various types of information and options for authorizing access to different groups. The information may represent a paper filled form, see column 6, lines 36-52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the objects in Benantar represent paper filled forms as taught in Tolopka as a convenient manner of obtaining personal information and populating as an object, see column 6, lines 36-52.

8. Claims 19, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benantar et al. (U.S. Pat. No. 5,787,427) in view of Gifford et al (U.S. Pat. No. 5,614,927).

The Benantar reference does not disclose transforming the personal information into a depersonalized format.

The Gifford reference teaches protection of confidential information in a database. Column 8, lines 1-8, teaches a method where the correlation between public attributes and private attributes are reduced by camouflaging or outright removing some data to depersonalize the identifiable information based on rules.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data in the object groups in Benantar be depersonalized, i.e. camouflaged or removed, as taught in Gifford in order to protect confidential information from being inferred from a database, see column 4, lines 17-68.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (571) 272-3799. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is 571-273-8300.

*Gilberto Barrón Jr.*  
GILBERTO BARRON JR  
SUPERVISORY PATENT EXAMINER  
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